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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,594	03/21/2002	Masato Ikeda	00005.001198	6859
5514	7590	10/14/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			FRONDA, CHRISTIAN L	
			ART UNIT	PAPER NUMBER

1652

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/088,594

Applicant(s)

IKEDA ET AL.

Examiner

Christian L Fronda

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 4-8, 10, 11, 13 and 14.

Claim(s) objected to: _____.

Claim(s) rejected: 12, 15, 17 and 18.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.


Continuation of 2. NOTE: Claims 13 and 14 as amended would be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not provide a description of the claimed genus of transformants overexpressing the claimed transaldolase, where the transformants would have a reduced ability to produce the substances recited in claim 13. The specification does not provide a description of the claimed genus of methods encompassed by claim 14, where the claimed methods produce any substance other than L-histidine, riboflavin, and nucleic acids. Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention.

Claim 17 stands rejected under 35 U.S.C. 112, first paragraph, for reasons of record because the specification does not reasonably provide enablement for any polynucleotide that encodes any polypeptide comprising the amino acid sequence of SEQ ID NO:1 in which one up to a few amino acids have been substituted, deleted or added and having transaldolase activity. In order to make the claimed invention one of ordinary skill in the art must perform an enormous and undue amount of trial-and-error experimentation to determine which amino acid residues to substitute, delete, or add to SEQ ID NO: 1. Teachings regarding screening and searching for the claimed invention which is not guidance for making the claimed invention

Claim 17 stands rejected under 35 U.S.C. 102(b) as being anticipated by Miyamoto et al. (Accession AAR63573)

The scope of the claim includes the polynucleotide taught by Miyamoto et al. (Accession AAR63573) since the recitation of "one up to a few" amino acids without stating the specific number of amino acid residues that are modified in SEQ ID NO: 1 does not limit the number of amino acid residues that can be modified.

Thus, the reference teachings of Miyamoto et al. anticipate the claimed invention since Miyamoto et al. teach a polynucleotide sequence which encodes a polypeptide sequence which has transaldolase activity and has an amino acid of SEQ ID NO: 1 in which "one up to a few" amino acids have been substituted, deleted, or added..


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